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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,025	07/24/2003	Karl Hakan Torbjorn Gardenfors	34650-179USC2	1268

7590 11/09/2004
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EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,025

Applicant(s)

GARDENFORS ET AL.

Examiner

Brian A Zimmerman

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 30-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/29/03</u> . | 6) <input type="checkbox"/> Other: ____. |

Informalities

The information disclosure statement filed 12/29/03 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. There is no statement of relevance for reference DE 19502111A1.

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2635

Claims 30-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6633550. Although the conflicting claims are not identical, they are not patentably distinct from each other because The pending claims are much broader than the patented claims. The patented claims include all the limitations of the pending claims. It is well held that in the case of broader claims in a child application, a double patenting rejection of the broader claims is warranted to prevent extension of the "right to exclude" granted by a patent.

Claim Rejections

1. Claim 30 is rejected under, MPEP 706.03(w). Claim 30 is identical to claim 25 decided by the Board of Appeals in application 08/803392.
2. Claims 30-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okanobu (GB 2296610).

Okanobu shows a radio on a single IC chip. Okanobu shows an antenna section for transmitting and receiving a plurality of HF signals and means for transmitting and receiving the HF signals, figures 1,2 page 1 lines 6-19. Okanobu shows a down conversion section coupled to the antenna for down converting a HF signal to a low IF signal, page 1 line 20-page 2 line 6. The particular IF chosen is well within the level of skill of an artisan. Okanobu shows bandpass filters 13,23 coupled to the down conversion section, page 4 lines 16-22. Okanobu shows a discriminator coupled to the bandpass filter, page 7 lines 9-14.

Art Unit: 2635

Okanobu shows an up conversion section coupled to the antenna for up converting a second HF signal, the up conversion section includes a portion of the down conversion section, elements 30,311,431, page 8 lines 1-13. Okanobu shows a shaping filter coupled to the input of the up conversion section, page 8 lines 1-3. Okanobu shows the use of variable controlled oscillator.

Okanobu differs from the claimed invention in that the claims use a single step heterodyne section, and time division mode. It is noted that Okanobu uses a super heterodyne section. The examiner takes official notice that the use of heterodyne converters and super heterodyne converters are verily well known equivalent conversion elements in communication devices, that perform the same functions, differing only in the clarity of the output of the received data slightly. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a heterodyne converter in place of the super heterodyne converter of the disclosed system by Okanobu, since these elements are virtually interchangeable in the art.

The examiner takes official notice that there various types of communication schemes to share bandwidth in data communication, examples are; frequency hopping, time division, code division...etc. All these techniques are commonly utilized to share bandwidth with other communication devices. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a time division mode in the above communication system since this would enable a single transceiver to share a communication spectrum with other transceivers in a manner common in the art.

Art Unit: 2635

Additionally, Okanobu does not expressly show all the claimed elements on a single IC. Okanobu does disclose all but the filter being on the same IC. It has been held that forming in one piece an article, which has formerly been formed in two pieces, and put together, involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have integrated the elements of Okanobu onto a single IC.

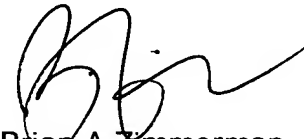
In their decision, the Board of Appeals noted that the preamble of this claim does not limit the scope of the claim, and thus the rejection based upon Okanobu was affirmed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A Zimmerman whose telephone number is 571-272-3059. The examiner can normally be reached on Off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 571-272-3068. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'B. Zimmerman', is positioned above the printed name.

Brian A Zimmerman
Primary Examiner
Art Unit 2635

BAZ